

Serial No. 10/056,312

Amendment in Resp. to Office Action of Sept. 20, 2004

UTILITY PATENT

B&D No. TN-1488

gear meshing with the first gear, and a second gear driven by the motor and meshing with the intermediate gear, wherein the intermediate gear is always meshing with the first and second gears, the second gear being driven by the motor via a belt, and a pivot arm pivotally attached to the table and supporting the saw assembly, the pivot arm and saw assembly being pivotable about a horizontal bevel axis from a first position where the blade is substantially perpendicular to the table to a second position where the blade is disposed at an angle relative to the table, the angle between the blade and the table being about 45 degrees, wherein a distance between the second portion and at least one of the base assembly and the table is smaller than a distance between the first portion and the at least one of the base assembly and the table when the saw assembly is in the second position.

Ushiwata discloses all elements called for in Claim 1 except for the second gear being driven by the motor via a belt. The Examiner relies on Tsune to provide such missing element because "it would have been obvious to provide a belt in Ushiwata as taught by Tsune in order to provide a backlash eliminator assembly, which eliminates backlash between gears."

This rejection is improper as the Examiner has failed to make a *prima facie* case of obviousness. To establish such case, there must be some suggestion or motivation to one of ordinary skill in the art to combine the reference teachings. MPEP § 2143. In the present case, no such suggestion or motivation exists to combine Ushiwata and Tsune as proposed by the Examiner. This is because neither Ushiwata nor Tsune suggest the desirability of the claimed invention.

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Under the MPEP, obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. MPEP § 2143.01. According to the Examiner, the motivation to provide a belt can be found in Tsune "in order to provide a backlash eliminator assembly, which eliminates backlash between gears."

According to Tsune, backlash eliminator 16 temporarily applies braking to the final stage gear 15 upon initiation of the cutting action. Tsune, col. 2, lines 24-28. Such backlash eliminator 16 includes braking gear 17 (which engages final stage gear 15), braking disk 19, brake shaft 18, calipers 21 and hydraulic cylinder 22. Tsune, col. 2, lines 29-41.

In other words, the backlash eliminator 16 does not include a pulley 9 or a belt. Accordingly, the pulley 9 and the belt do not interact with backlash eliminator 16 to provide the backlash eliminating function. Because pulley 9 and belt do not assist in the backlash eliminating function, a person skilled in the art would install not a pulley and/or belt to provide a backlash eliminating function pursuant to Tsune. Therefore, the motivation to combine the references stated by the Examiner is invalid.

Furthermore, neither Ushiwata nor Tsune suggest the desirability of the claimed invention. The claimed invention is desirable because it provides a higher cutting capacity in different cutting orientations than a saw with the same blade size incorporating the Ushiwata transmissions. If a person skilled in the art were to review Tsune, such person would not learn from Tsune that providing pulley 9 on Ushiwata could result in increased cutting capacity. This

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is because the location of pulley 9 in Tsune does not affect Tsune's cutting capacity.

Accordingly, Tsune cannot suggest a relationship between cutting capacity and the presence of a pulley.

Because neither Ushiwata nor Tsune disclose or suggest the desirability of the claimed invention, no motivation to combine the references exists. Therefore, no proper *prima facie* case of obviousness can be made.

In view of the foregoing, the claim is patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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